

## REMARKS

Claim 3 has been cancelled. Claims 1, 2, 5 to 9, and 38 to 56 are pending.

### Terminal Disclaimer

Applicant thanks the Examiner for noting the entry of the terminal disclaimer; however, Applicant wishes to clarify that he has not disclaimed the term beyond February 10, 2004. The term disclaimed was that beyond the expiration of US 6,689,941, which issued on February 10, 2004.

### Rejections under 35 U.S.C. § 112, first paragraph:

Claims 1 to 3, 5 to 9, 46 to 48, and 51 to 56 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement for the reasons of record in the Final Office Action of May 19, 2006.

Applicant disagrees and notes that the Examiner has not substantively addressed the arguments set forth in the Appeal Brief filed January 22, 2007.

The Examiner admits that Applicant has possession of breeding lines PSR 6425, PSR 6595, and PSR 6032. However, because those "lines are not claimed in claims 1-3, 5-9, 46-48 and 51-56" each claim has been rejected. See the Office Action of May 3, 2007 at page 4. Applicant respectfully submits that the attempt by the Examiner to limit the claims to the exemplified embodiments is contrary to established case law and that written description may be met even where an actual reduction to practice is absent. *Falkner v. Ingis*, 448 F.3d 1357, 1366 (Fed. Cir. 2006); *see also, Ralston-Purina Co. v. Far-mor-Co*, 772 F.2d 1570, 1575, 227 U.S.P.Q. 177, 179 (Fed. Cir. 1985) (claims "may be broader than the specific embodiment disclosed in a specification") (*quoting In re Rasmussen*, 650 F.2d 1212, 1215, 211 U.S.P.Q. 323, 326 (C.C.P.A. 1981)). The lines set forth in the examples are merely embodiments of the overall invention. As discussed below, the specification provides sufficient written description of the invention, which is broader than lines PSR 6425, PSR 6595, and PSR 6032.

**The Specification Provides an Adequate Written Description of the Claimed Invention**

The adequacy of the written description of the invention of claims 1 to 3, 5 to 9, 46 to 48, and 51 to 56 has been challenged by the Examiner because the claimed subject matter was allegedly “not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s)...had possession of the claimed invention.” Final Action at page 3, Office Action of May 3, 2007, at page 3. The Examiner contends that “there is no evidence in the specification that would allow one skilled in the art to conclude that Applicant has possession of all lettuce plants having the claimed characteristics.” Final Action at page 4. Applicant submits that the specification demonstrates to one skilled in the art that Applicant was in possession of the claimed genera of lettuce plants and methods for their production.

**(1) The Specification Reflects Applicant’s Possession of the Claimed Invention**

The purpose of the written description requirement is to ensure that the inventor had possession of the claimed subject matter, *i.e.*, to ensure that the inventors actually invented what is claimed. *Gentry Gallery Inc. v. Berkline Corp.*, 134 F.3d 1473, 1479, 45 U.S.P.Q.2d 1498, 1503 (Fed. Cir. 1998); *Lockwood v. American Airlines*, 107 F.3d 1565, 1572, 41 U.S.P.Q.2d 1961, 1966 (Fed. Cir. 1997); *In re Alton*, 76 F.3d 1168, 1172, 37 U.S.P.Q.2d 1578, 1581 (Fed. Cir. 1996). If a person of ordinary skill in the art would, after reading the specification, understand that the inventor had possession of the claimed invention, even if not every nuance, then the written description has been met. *In re Alton*, 76 F.3d at 1175, 37 U.S.P.Q.2d at 1584.

The court determined, in *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 296 F.3d 1316, 1321, 63 U.S.P.Q.2d 1609, 1610 (Fed. Cir. 2002), that the written description inquiry is a factual one determined on a case-by-case basis. *Enzo*, 296 F.3d at 1326-1327, 63 U.S.P.Q.2d at 1615. Furthermore, it is well established that claims “may be broader than the specific embodiment disclosed in a specification. *Ralston-Purina Co. v. Far-mor-Co*, 772 F.2d 1570, 1575, 227 U.S.P.Q. 177, 179 (Fed. Cir. 1985) (*quoting In re Rasmussen*, 650 F.2d 1212, 1215, 211 U.S.P.Q. 323, 326 (C.C.P.A. 1981)). The Federal Circuit has elucidated a test for written description wherein if a generic claim may be described by a structural feature that distinguishes members of the claimed genus from non-members of the claimed genus, written description is

satisfied. *Regents of the University of California v. Eli Lilly and Co.*, 119 F.3d 1559, 1568-69, 43 U.S.P.Q.2d 1398, 1406 (Fed. Cir. 1997).

The Examiner asserts that “[t]he specification does not allow one skilled in the art to distinguish the claimed invention from any other lettuce plants with the same characteristics”, and accordingly, Applicant has allegedly not adequately disclosed the claimed iceberg lettuce plants. Final Action at page 4.

A person of ordinary skill in the art would, after reading the present specification, understand that Applicant had possession of iceberg lettuce cultivars having a first outer leaf having a length to width ratio between about 1.2 to about 2.7, and a color ranging from about RHS 146A to about RHS 146B, and parts of such cultivars and methods of producing such cultivars. Applicant has provided structural features and characteristics, including leaf structure and color, of the claimed iceberg cultivars. Accordingly, Applicant has demonstrated possession of the claimed invention.

In particular, Applicant has disclosed common structural features, for example iceberg lettuce plants having first outer leaves having a length to width ratio between about 1.2 and about 2.7, and leaf color ranges. *See, e.g.*, specification at page 16, paragraph [00059] through page 18, paragraph [00060]. The specification also discloses first outer leaves, as well as methods for measuring the length to width ratio. *See, e.g.*, specification at page 5, paragraphs [00018] through [00019]. The skilled artisan could readily recognize iceberg lettuce plants within the claimed genus. For example, if a particular iceberg lettuce cultivar contains a first leaf having a length to width ratio between about 1.2 and about 2.7 and has a color in the range from about RHS 146A to about RHS 146B, then it is a member of the claimed genus of iceberg lettuce cultivars. The fact that the cultivars may comprise additional traits or characteristics is beside the point. Such modifications are readily envisioned by one of ordinary skill in the art and disclosed throughout the specification.

Moreover, the present application describes more than just a single embodiment of an iceberg lettuce cultivar having the claimed leaf structure and color. For example, the specification describes iceberg lettuce cultivars having a first outer leaf having a length to width ratio between about 1.2 to about 2.7 (*See, e.g.*, specification at page 9, paragraph [00044]) and describes methods for breeding such cultivars. *See, e.g.*, specification at page 6, paragraph

[00026] through page 7, paragraph [00031], and page 10, paragraph [00048] through page 12, paragraph [00052]. Furthermore, the specification exemplifies multiple L. sativa cultivars having a first outer leaf having a length to width ratio between about 1.2 and about 2.7 (*See, e.g.*, specification at page 17, Table 3, page 15, Table 2, page 19, Table 4, page 21, Table 5, and page 13, Table 1).

Additionally, the specification also discloses sources of iceberg lettuce plants having corky root resistance and lettuce mosaic virus resistance, and methods for the identification of such resistance (*See, e.g.*, specification at page 8, paragraph [00032] through page 9, paragraph [00039], page 23, paragraph [00070], and page 24, paragraph [00077]). The specification further discloses iceberg lettuce plants having blanched inner leaf colors ranging from about RHS 145C to about RHS 145D, as well as those also having a semi-open head as described in UPOV guidelines TG/13/7. *See, e.g.*, specification at page 5, paragraph [00021] and page 10, paragraph [00046].

The specification discloses iceberg lettuce plants, including deposited lines PSR 6425, PSR 4570, and PSR 4569, having the claimed leaf structures and leaf colors, and resistance. Based on such disclosure, the skilled artisan can readily distinguish the claimed invention from other lettuce plants. In view of the foregoing, Applicant has satisfied the test for written description, and the rejection should be reversed.

## **(2) Applicant Has Described the Claimed Invention of Claims 41-45 and 49-55**

The Examiner asserts that the claimed hybrid plants are not described because “[k]nowing half of the genetic composition of a plant is not an adequate description because a hybrid will possess 50% of the genes of the other parent wherein these genes will play a significant role in the morphological and physiological characteristics of the claimed hybrid.” Final Action at page 5.

As set forth above, Applicant has disclosed the genus of iceberg lettuce cultivars having a first leaf having a length to width ratio between about 1.2 and about 2.7 and has a color in the range from about RHS 146A to about RHS 146B. The specification also discloses iceberg lettuce lines of PSR 6425, PSR 6595, and PSR 6032, and seeds obtained from such lines.

The Examiner, however, argues that knowing “half of the genetic composition of a plant is not an adequate description because a hybrid will possess 50% of the genes of the other parent wherein these genes will play a significant role in the morphological and physiological characteristics of the claimed hybrid.” Final Action at page 5. Contrary to the Examiner’s assertion that the claims do not recite any morphological or physiological characteristics, claims 51-55 recite a variety of morphological characteristics, and claims 41-45 and 49-50 recite at least the lineage of the claimed F1 hybrids from deposited lines PSR 6425, PSR 6595, or PSR 6032. Those are enough of “morphological or physiological” characteristics to distinguish the claimed plants from other plants. For example, a plant or seed of claims 41-45 and 49-50 can be distinguished by using genetic testing to determine if one of its parents is selected from PSR 6425, PSR 6595, or PSR 6032. Moreover, the Examiner has not challenged the adequacy of the description of the parent lines PSR 6425, PSR 6595, or PSR 6032. As the plants of PSR 6425, PSR 6595, or PSR 6032 have been described, the subject matter of claims 41-45 and 49-50 is also described.

In conclusion, Applicant respectfully submits that the entire scope of claims 1 to 3, 5 to 9, 46 to 48, and 51 to 56 is in compliance with the written description requirement of 35 U.S.C. § 112, first paragraph, and respectfully requests withdrawal of this rejection.

**Claims 1 to 3, 5 to 9, 46 to 48, and 51 to 56 Were Rejected Under 35 U.S.C. § 112, First Paragraph as Allegedly Lacking Enablement**

Claims 1 to 3, 5 to 9, 46 to 48, and 51 to 56 were rejected under 35 U.S.C. § 112, first paragraph “because the specification, while enabling for lettuce breeding lines PSR 6425, PSR 6595 and PSR 6032, [purportedly] does not reasonably provide enablement for all iceberg lettuce cultivars comprising a first outer leaf having a length to width ratio between 1.2 to about 2.7 and a color which ranges from about RHS 146A to about RHS 146B.” Office Action of May 3, 2007 at page 5. The Examiner goes on to state that the “invention is not enabled because it is unclear how one skilled in the art would make the invention”, as “[i]t is unclear if the claimed invention is produced by using one or more of lettuce breeding lines PSR 6425, PSR 6595, and PSR 6032 as a parent.” *Id.* It is further alleged that “the specification teaches one skilled in the art how to

make lettuce breeding lines PSR 6425, PSR 6595, and PSR 6032 and not all cultivars having a length to width ratio between about 1.2 to 2.7.” *Id.* at 5-6.

Applicant respectfully disagrees. The Examiner has not adequately addressed Applicant’s arguments with respect to enablement as set forth in the Appeal Brief filed January 22, 2007. Indeed, the Examiner also appears to have ignore the requirements of M.P.E.P. § 2164.01(a), which states that it is improper to conclude that a disclosure is not enabling based on an analysis of only one of the *Wands* factors while ignoring one or more of the others. “The Examiner’s analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole.” M.P.E.P. § 2164.01(a); *In re Wands*, 858 F.2d 731, 740 (Fed. Cir. 1988). The Examiner appears to have focused his attention solely on the exemplified lines PSR 6425, PSR 6595 and PSR 6032, and not on other applicable evidence of enablement. For example, the Examiner has not addressed, among other items, the nature of the invention, the state of the prior art, the level of one of ordinary skill, and the amount of direction provided by the Applicant.

Applicant respectfully submits that when the evidence related to all the *Wands* factors is taken into consideration, the specification as filed enables the entire scope of claims 1 to 3, 5 to 9, 46 to 48, and 51 to 56 as discussed below.

### (1) The Specification Enables the Full Scope of the Claimed Invention

A specification that discloses how to use a claimed invention “must be taken as in compliance with the enabling requirement of the first paragraph of § 112 unless there is reason to doubt the objective truth of the statements contained therein.” *In re Brana*, 51 F.3d 1560, 1566, 34 U.S.P.Q.2d 1436, 1441 (Fed. Cir. 1995), quoting *In re Marzocchi*, 439 F.2d 220, 223, 169 U.S.P.Q. 367, 369 (C.C.P.A. 1971) (emphasis in original). The present specification indeed discloses how to make and use the present invention, for example by providing methods for breeding iceberg lettuce cultivars having a first outer leaf having a length to width ratio between about 1.2 to about 2.7 and a color in the range from about RHS 146A to about RHS 146B, including pedigree selection methods and selection criteria that can be used in such methods. See, e.g., Specification at page 6, paragraph [00026] through page 7, paragraph [00031]. Moreover, the specification describes numerous characteristics of the iceberg lettuce cultivars of

the present invention, for example, leaf shape and color, leaf length to width ratio, and disease resistance. *See*, Specification at page 9, paragraph [00042] through page 10, paragraph [00046]. In addition, the specification provides working examples of the preparation of iceberg lettuce cultivar PSR 6425, as well as other iceberg lettuce cultivars within the genus of claimed iceberg lettuce cultivars. *See, e.g.*, Specification at page 10, paragraph [00048] through page 22, paragraph [00064]. As such, the specification provides ample guidance to the skilled artisan to produce the lettuce plants as presently claimed.

The Examiner has provided neither evidence supporting the rejection nor any explanation of why the specification allegedly fails to enable the claimed plants. *See In re Wright*, 999 F.2d 1557, 1561-62, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993); *Ex parte Lemak*, 210 U.S.P.Q. 306, 307 (Bd. App. 1981) (“pure conjecture” does not substantiate rejection for lack of enablement). Therefore, as the specification enables at least the methods of making and using the invention as set forth in the Examples, absent evidence or an explanation by the Examiner, the enablement requirement has been satisfied. *See, Johns Hopkins University v. CellPro*, 152 F.3d 1342, 1361, 47 U.S.P.Q.2d 1705, 1719 (Fed. Cir. 1998) (“the enablement requirement is met if the description enables any mode of making and using the invention”) (emphasis added), quoting *Engel Indus. v. Lockformer Co.*, 946 F.2d 1528, 1533, 20 U.S.P.Q.2d 1300, 1304 (Fed. Cir. 1991).

## (2) The Specification Enables the Claimed Invention of Claims 8-9

The specification enables the methods of producing iceberg lettuce plants having the recited leaf length to width ratio. As set forth above, Applicant has provided the claimed iceberg lettuce cultivars having a first outer leaf length to width ratio of about 1.2 to about 2.7. Moreover, the specification discloses breeding methods for obtaining iceberg lettuce cultivars having the recited characteristics. *See, e.g.*, Specification at page 10, paragraph [00048] through page 13, paragraph [00054].

The specification further discloses examples of selection methods for identifying plants having the recited characteristics, such as the first outer length to width ratios (*See, e.g.* specification at page 5, paragraph [00019]), spatulate leaf shape (*See, e.g.*, specification at page 9, paragraph [00042]), semi-open head (*See, e.g.*, specification at page 10, paragraph [00046]),

elliptical stature (*See, e.g.*, specification at page 9, paragraph [00042]), resistance to corky root rot (*See, e.g.*, specification at page 7, paragraph [00032] through page 8, paragraph [00036] and Example 5), resistance to lettuce mosaic virus (*See, e.g.*, specification at page 8, paragraph [00037] through page 9, paragraph [00039] and Example 6), and plant height (*See, e.g.*, specification at page 5, paragraph [00022]). The specification also discloses methods for pedigree and hybrid selection. *See, e.g.*, specification at page 6, paragraph [00026] through page 7, paragraph [00030].

The skilled artisan, based on the specification, would be able to produce iceberg lettuce cultivars using the claimed methods without undue experimentation. Accordingly, claims 8-9 are enabled, and the rejection should be reversed.

**(3) The Choice to Employ Lines PSR 6425, PSR 6595, and PSR 6032, as  
Opposed to Other Lettuce Lines, to Produce the Claimed Lettuce Plants Is  
Not Relevant to the Enablement Inquiry**

The Examiner alleges that the invention is not enabled because it “is unclear how one skilled in the art would make the claimed invention.” The Examiner states “[i]t is unclear if the claimed invention is produced by using one or more of lettuce breeding lines PSR 6425, PSR 6595, and PSR 6032 as a parent.” Office Action of May 3, 2007, at page 5. The choice to employ lines PSR 6425, PSR 6595, and PSR 6032, as opposed to other lettuce lines, to produce the claimed plants is not relevant to an enablement inquiry where at least one means of making and using an invention is disclosed. The “enablement requirement is met if the description enables any mode of making and using the invention” *Engel Indus. v. Lockformer Co.*, 946 F.2d 1528, 1533, 20 U.S.P.Q.2d 1300, 1304 (Fed. Cir. 1991) (emphasis added). As discussed above, at least one method of making and using the claimed plants has been described and thus the enablement requirement has been met.

Moreover, it is well established that Applicant need not teach conventional and well-known techniques (*see, e.g.*, *Ajinomoto Co. v. Archer-Daniels-Midland Co.*, 228 F.3d 1338, 1345, 56 U.S.P.Q.2d 1332, 1337 (Fed. Cir. 2000)), which would include lettuce breeding techniques for obtaining F<sub>1</sub> hybrids of the iceberg lettuce cultivars, as well as parameters for selecting parents for use in such techniques. Further, the performance of routine and well-known

steps cannot create undue experimentation even if they are laborious. In addition, to the extent that the Office suggests there is a requirement for *a priori* predictability without recourse to any experimentation, that position is without legal support. *Cf. Atlas Powder Co. v. E. I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1576, 224 U.S.P.Q. 409, 413 (Fed. Cir. 1984) (“[t]hat some experimentation is necessary does not preclude enablement”).

**Claims 38 to 40 Were Rejected Under 35 U.S.C. § 112, First Paragraph, As Allegedly Failing to Comply With the Enablement Requirement**

Claims 38 to 40 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement because, according to the Examiner “it is unclear which seeds are being deposited,” and [i]f the deposit is a mixed deposit, it is unclear how one skilled in the art would be able to distinguish the different seeds from each other.

Applicant respectfully submits that claims 38-40 do not require separating or identifying seeds. Claim 38 provides for [a] seed of an iceberg lettuce plant of claim 1, wherein said seed is from a *Lactuca sativa L* line selected from the group consisting of PSR 6425; PSR 6595; and PSR 6032 (American type Culture Collection under accession number PTA-3248). Growing seed from the deposit would enable a person to make and use a plant within the scope of claim 38. If one chooses to separate the seeds from the lines deposited, the specification indicates that of the three varieties only PSR 6032 has black seeds, so that the seed of that line can be segregated out; seeds of the other two varieties that have white seeds can be identified by growing plants and determining their phenotypic characteristics.

If it is deemed necessary, a replacement deposit of lettuce lines PSR 6425, PSR 6595, and PSR 6032 will be submitted with a depository in accordance with 37 C.F.R. § 1.805, prior to the payment of the issue fee.

**Rejections under 35 U.S.C. § 102:**

Anticipation under 35 U.S.C. § 102 can only be found if a reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780 (Fed. Cir. 1985). Furthermore, anticipation requires that every limitation of the claims be found, either expressly or inherently, in a single prior art reference, device, or practice.

**Claims 1, 5, and 7 Were Rejected Under 35 U.S.C. § 102(b) As Allegedly Being Anticipated By Miltz (U.S. Pat. No. 5,220,113)**

The Examiner states that, “Miltz discloses an iceberg lettuce cultivar, namely ‘BUD 71-3’, having a length to width ratio between about 1.2 to about 2.7, namely 1.5, and a color range from about RHS 146A to about RHS 146B, namely RHS 146B …”. The Examiner cites to column 4, line 52, through column 5, line 4, and column 1, line 53, of Miltz for support.

Applicant disagrees.

Applicant respectfully submits that neither column 4, line 52 to column 5, line 4 nor column 1, line 53 of Miltz provides support for the Examiner’s contentions. Whatever else Miltz teaches, it does not teach an iceberg lettuce cultivar, or a part thereof, wherein said iceberg lettuce cultivar comprises a first outer leaf having a length to width ratio between about 1.2 to about 2.7 and a color which ranges from about RHS 146A to about RHS 146B. Column 4, lines 61 to 63, at most states that the length/width index of the fourth leaf is 1.5. The Examiner has therefore failed to demonstrate that each and every limitation of the claims is found in Miltz. Therefore, Miltz cannot anticipate claims 1, 5, and 7.

In addition to the arguments set forth above, the Examiner is also mistaken in asserting that claim 5 is within the scope of the Miltz patent. Whatever else Miltz teaches, it does not teach the varieties described therein, and specifically BUD 71-3, have inner leaves meeting the specified color range. The passage relied on by the Examiner at most states one common morphological characteristic of Vanguard-type lettuce cultivars is “[h]eads with creamy colored interiors.” The Examiner has not, however, established that that description corresponds to a color ranging from about RHS 145C to about RHS 145D. Moreover the Examiner has not even established that BUD 71-3 is a member of the Vanguard-type of cultivar, let alone that it has the

specific characteristic mentioned. Thus, to meet the limitations of claim 5, the Examiner is creating a hypothetical cultivar from passages in the background of the patent and other passages in the detailed description.

Applicant notes the Examiner rejects claims 1, 5, and 7 relying on *In re Thorpe* for the proposition that a product-by-process claim may be properly rejectable over prior art teaching the same product produced by a different process. Office Action of May 3 at page 7. Applicant respectfully draws the Examiner's attention to the fact that none of claims 1, 5, or 7 is a product-by-process claim.

In an attempt to place the burden of demonstrating novelty and non-obviousness upon Applicant, the Examiner relies upon *In re Best*. Office Action of May 3 at page 7. That reliance is misplaced. The *Best* court stated “[w]here... the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product.” *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977). As the Miltz product relied upon by the Examiner, *i.e.*, BUD 71-3, does not even seem to be substantially identical to the claimed product, *In re Best* offers the Examiner no basis upon which to switch the burden to Applicant. Applicant respectfully maintains that he is under no obligation to submit evidence of novelty or non-obviousness under *In re Best* unless and until the Examiner establishes that the claimed invention is at least substantially identical to the product relied upon in Miltz.

Further to the foregoing, Applicant has amended independent claim 1 to recite that the plants have an elliptical stature. The BUD 71-3 variety cited against Applicant's claims is described by Miltz as being spherical at column 5, lines 10-15, and the Examiner admits Miltz does not teach elliptical shaped heads. Office Action of May 3, 2007, at page 9.

In conclusion, Applicant respectfully submits that claims 1, 5, and 7 are not anticipated by Miltz and respectfully requests withdrawal of this rejection.

**Claim 1 Was Rejected Under 35 U.S.C. § 102(b) As Allegedly Being Anticipated By Waycott et al. (U.S. Pat. No. 5,973,232)**

Applicant respectfully traverses. According to the Examiner, “Waycott et al. disclose an iceberg lettuce cultivar, namely ‘Sharp Shooter’, comprising a length to width ratio between about 1.2 to about 2.7, namely 1.7 …”. Office Action at page 8. The Examiner cites to column 2, lines 27-28 and column 5, line 41 of Waycott et al. for support. Unfortunately, the teachings at column 2, lines 27-28 and column 5, line 41 either alone or in combination fail to provide support for the Examiner’s contentions. The teachings fail as column 5, line 41, states that the length/width index of the fourth leaf is 1.7.

It is axiomatic that, in order for a prior art reference to anticipate a claim, the reference must teach every element of the claim. *See*, M.P.E.P. § 2131. Whatever else Waycott et al. teach about the shape of the 4<sup>th</sup> leaf, they do not teach or fairly suggest “[a]n iceberg lettuce cultivar, or a part thereof, wherein said iceberg lettuce cultivar has an elliptical stature and comprises a first outer leaf having a length to width ratio between about 1.2 to about 2.7 and a color which ranges from about RHS 146A to about RHS 146B. Moreover, as noted above, Applicant has amended claim 1 to recite that the plants have an elliptical stature. The stature of the lettuce described by the ‘113 patent is recited as being spherical at column 6, line 24.

In view of the foregoing, Waycott et al. cannot anticipate claim 1.

As in the rejection over the Miltz reference, the Examiner relies on *In re Thorpe* for the proposition that a product-by-process claim may be properly rejectable over prior art teaching the same product produced by a different process. Office Action of May 3 at page 8. Applicant again respectfully draws the Examiner’s attention to the fact that claim 1 is not a product-by-process claim.

Moreover, as with the rejection over the Miltz citation, the Examiner again relies upon *In re Best* in an attempt to place the burden of demonstrating novelty and non-obviousness upon Applicant. Office Action of May 3 at page 8. That reliance is misplaced for the same reasons it was misplaced in the Examiner’s formulation of the Miltz rejection under section 102(b). As the product relied upon by the Examiner does not even seem to be substantially identical to the claimed invention, *In re Best* offers the Examiner no basis upon which to switch the burden to Applicant. Applicant respectfully submits he is under no obligation to submit evidence of

novelty or non-obviousness under *In re Best* unless and until the Examiner establishes that the claimed invention is at least substantially identical to the product relied upon in Waycott.

In conclusion, Applicant respectfully submits that claim 1 is not anticipated by Waycott *et al.* and respectfully requests withdrawal of this rejection.

**Rejections under 35 U.S.C. §103:**

**Claims 1 to 3, 5 to 7, and 41 to 56 Were Rejected Under 35 U.S.C. § 103(a) As Allegedly Being Unpatentable Over Miltz in View of Tillge, Further in View of Bassett**

Claims 1 to 3, 5 to 7, and 41 to 56 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Miltz in view of Tillge (*Seed Sci. Tech.* 12, 919-933, 1984), further in view of Bassett (*J. Am. Soc. Hort. Sci.* 100(2), 104-105, 1975).

Applicant disagrees. Applicant has identified a new and useful type of lettuce that is neither anticipated nor made obvious by the art relied upon by the Examiner.

The Supreme Court recently addressed the issue of obviousness in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007). The Court stated that the *Graham v. John Deere Co.*, 383 U.S. 1 (1966), factors still control an obviousness inquiry. Those factors are: 1) “the scope and content of the prior art”; 2) the “differences between the prior art and the claims”; 3) “the level of ordinary skill in the pertinent art”; and 4) objective evidence of nonobviousness. *KSR*, 127 S. Ct. at 1734 (quoting *Graham*, 383 U.S. at 17-18) ‘The gap between the prior art and the claimed invention may not be ‘so great as to render the [claimed invention] non-obvious to one reasonably skilled in the art.’’’ Examination Guidelines for determining Obviousness under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International v. Teleflex, Inc.* Fed. Reg. 57,526, 57,528 (Oct. 10, 2007) (relying on and quoting from *Dann v. Johnson*, 425 U.S. 219, 230 (1976)). Office personnel must provide an explanation to support an obviousness rejection. *Id.* at 57,527. That explanation must include a rational underpinning to support the legal conclusion of obviousness. See, *KSR International Co.* 127 S. Ct. at 1741 (discussing obviousness analyses and citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Furthermore, the prior art references must teach or suggest all of the claim limitations. *In re Royka*, 409 F.2d 981, 984 (CCPA 1974).

The Examiner has failed to address all of the limitations of the claims. Each of claims 41-45, 49 and 50 depends directly, or indirectly, from claim 38. Nowhere does the Examiner address the specific lines, PSR 6425; PSR 6595; and PSR 6032, set forth in claim 38.

Claims 1-3, 5-7, 46-48 and 51-56 cannot be obvious over the combination of Miltz, Tillage and Bassett. As indicated in response to the anticipation rejection of claims 1, 5, and 7 over the Miltz patent, *supra*, that reference does not teach or fairly suggest an iceberg lettuce comprising a first outer leaf having a length to width ratio between about 1.2 to about 2.7 and a color which ranges from about RHS 146A to about RHS 146B. Moreover, the Examiner admits that Miltz does not teach a spatulate leaf shape, elliptical leaf stature, or semi-open head. As the Examiner has determined that the art is non-enabling (see the enablement rejection at pages 5-6 of the Office Action of May 3, 2007), Tillge and Bassett, alone or in combination, cannot make up for those deficiencies of Miltz. In view of the foregoing, the enablement rejection is in conflict with the obviousness rejection and both rejections should be withdrawn.

The Examiner provides no sustainable rationale to support a rejection under 103(a). The Examiner admits Miltz does not teach all of the elements of the claims and attempts to rationalize the use of the Tillge and Bassett references to bridge the gap between that which is claimed and the cited references. In doing so, the Examiner provides two rationales and a statement of expected success in support of his allegation of obviousness. Each of those rationales and the statement are insufficient, incorrect, or both, and therefore cannot support the combination.

The Examiner's first rationale for combining Miltz is that "lettuce is a commercially important crop." That rationale is so generic that it cannot provide a rational underpinning to support the legal conclusion of obviousness. Indeed, under that rationale nothing that is "commercially important" could ever be non-obvious.

The Examiner's second rationale, which relies upon Bassett's statement that "L.I. selection may be more effective than selection on the basis of appearance" is flawed. Bassett, teaches that selection should be for high L.I. as "[t]here appears to be a strong association between high L.I. and the consistent heading tendency." Bassett at page 105 (emphasis added). However, L.I. is measured as width/length which is the inverse of the ratio Applicant uses. See Bassett at 104. It would thus be irrational to select based on high L.I. as defined by Basset to

obtain the claimed invention. In diametric contrast to the claimed invention, selecting for a high L.I. would produce leaves with a greater width than length.<sup>1</sup>

The Examiner's statement of expected success is belied by the enablement rejection. In that statement the Examiner relies on Miltz's teaching one variety. Importantly, the statement of expected success does not address the expectation of successfully bridging the gap between the claimed invention and the art cited. Bridging that gap requires introducing into Miltz's variety the lettuce characteristics from Tillge or Bassett to achieve the claimed inventions. However, the Examiner has indicated that one of ordinary skill in the art could not bridge the gap between the prior art and the claimed invention when rejecting the claims under 112 first paragraph.

The rejection over the combination of Miltz, Tillge, and Bassett, fails to accurately assess the differences between the prior art and the claims, and fails to accurately assess objective evidence of nonobviousness as required under the *KSR* decision. Based upon the teachings of Bassett the ordinary artisan would have understood that a high L.I. was desirable in crisp head lettuce plants as that promotes good head formation. The Examiner fails to accurately assess or appreciate that distinction present in the prior art, which is relevant to the instant claims as they are directed to crisp head lettuce with a relatively low L.I. Moreover, as Bassett teaches the value of heading in crisp head lettuce, and that there appears to be a strong association between heading and high L.I., the reference teaches away from preparing crisp head lettuce with a low L.I.

Therefore, claims 1 to 3, 5 to 7, and 41 to 56 are not unpatentable under 35 U.S.C. § 103(a) over Miltz in view of Tillge and further in view of Bassett and Applicant respectfully requests withdrawal of this rejection.

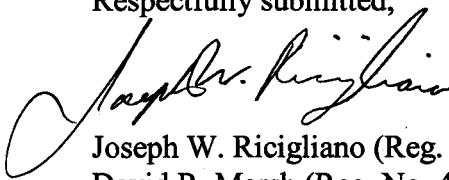
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<sup>1</sup> Bassett makes it clear in the abstract that a high L.I (width/length) results in leaves that are wider than long. In the last sentence of the abstract Bassett indicates that an "increase [in] the leaf index... produce[d] leaves which were wide at the base."

**CONCLUSION**

In view of the above, each of the presently pending claims is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding objections and rejections to the claims, and to pass this application to issue. The Examiner is encouraged to contact the undersigned at 202-942-5174 should any additional information be necessary for allowance.

Respectfully submitted,



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